

REMARKS/ARGUMENTS

Claims 1-9 and 33-41 are pending in the above-referenced patent application and are currently under examination. With entry of the present Amendment, claims 1 and 33 have been amended in accordance with the Examiner's suggestion to recite "a constitutive androstane receptor (CAR)-mediated disorder or condition, wherein the CAR-mediated disorder or condition is hypercholesterolemia." Support for the amendment to claims 1 and 33 can be found throughout the specification and claims as originally filed. In view of the amendment to claims 1 and 33 and in order to expedite prosecution, claim 3 has been canceled without prejudice to subsequent prosecution in a related application. Thus, no new matter has been introduced by this amendment, and this amendment does not necessitate a new search. Accordingly, Applicants respectfully request entry of this amendment.

In the present Office Action, the pending claims, *i.e.*, claims 1-9 and 33-41, were rejected under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 112, second paragraph. Each of these rejections is addressed in turn below in the order set forth by the Examiner.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-9 and 33-41 remain rejected under 35 U.S.C. § 112, first paragraph, because "the specification, while being enabling for methods of identifying agents that affect hypercholesterolemia does not reasonably provide enablement for identifying agents that affect CAR-related diseases that involve aberrant cholesterol levels" (*see*, page 2 of the Office Action).

As explained in the previously filed Amendment, the specification enables methods for identifying agents that affect CAR-related diseases that involve aberrant, *i.e.*, abnormal, cholesterol levels without undue experimentation. However, in order to expedite prosecution, claims 1 and 33 have been amended in accordance with the Examiner's suggestion to recite "a constitutive androstane receptor (CAR)-mediated disorder or condition, wherein the CAR-mediated disorder or condition is hypercholesterolemia." In addition, claim 3 has been canceled without prejudice to further prosecution in a related case. In view of the amendments

to the claims, the Examiner's rejection is rendered moot. Accordingly, Applicants urge the Examiner withdraw the rejection under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-9 and 33-41 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In support of this rejection, the Office Action states that the use of the phrase "aberrant cholesterol levels" is unclear.

Applicants respectfully submit that the meaning of the phrase "aberrant cholesterol levels," which is set forth in the specification as originally filed (*see, e.g.*, page 15, lines 22-23), would be understood by those of skill in the art to refer to abnormal cholesterol levels. However, in order to expedite prosecution, claims 1 and 33 have been amended in accordance with the Examiner's suggestion to recite "a constitutive androstane receptor (CAR)-mediated disorder or condition, wherein the CAR-mediated disorder or condition is hypercholesterolemia." In addition, claim 3 has been canceled without prejudice to further prosecution in a related case. In view of the amendments to the claims, the Examiner's rejection is rendered moot. Accordingly, Applicants urge the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/760,364

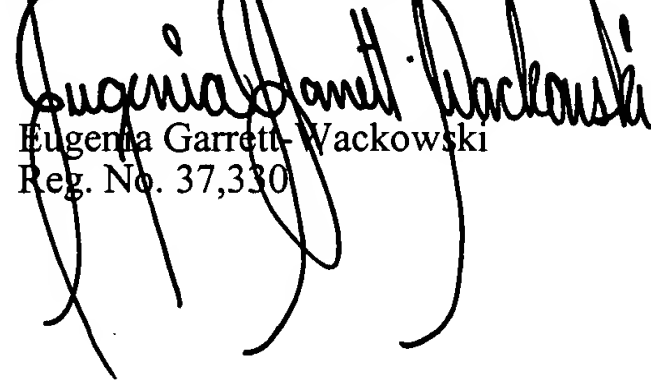
Amdt. dated June 17, 2004

Reply to Office Action of December 17, 2003

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eugenia Garrett Wackowski". The signature is fluid and cursive, with the first name "Eugenia" being the most prominent.

Eugenia Garrett Wackowski
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